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08/627,386	04/04/1996	GUNTER BAUR	MERCK-1753-D	8932

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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 31

Application Number: 08/627,386

Filing Date: 04/04/1996

Appellant(s): Baur et al

Csaba Henter, Anthony Zelano

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/28/02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be direct affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment of 2/28/02 cancelling claims 86 and 87 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) ***Grouping of Claims***

The rejection of claims stand or fall together because appellant's brief does not include a statemen that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) ***Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) ***Prior Art of Record***

No new prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) ***Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

1. Claim 20-35, 37-85, 88-124 (all claims) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,841,498. This rejection is set forth in prior Office Action, Paper No. 24.

2. Claim 20-35, 37-85, 88-124 (all claims) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,841,499 This rejection is set forth in prior Office Action, Paper No. 24.

(11) *Response to Argum*

As applicant has not argued patentable distinctness of the current claims from the claims of the patent, but that the previously filled terminal disclaimer to patent # 5,576,867 obviates the need to file new terminal disclaimers to patents #5,841,498 and #5,841,499 (the patents in question). Applicant argues tha since patents #5,841,498 and 5,841,499 are themselves terminally disclaimed to patent # 5,576,867, no difference in term will occur between those patents and the instant application, so the requirements of a terminal disclaimer have been met. As indicated on page 2 of the rejection, the nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" grante by a patent and to prevent possible harassment by multiple assignees. See *In re Van Ornum*, 686 F.2d 937

In the instant case, if the maintenance fees are not paid on patent # 5,576,867, the patents in questi and the instant application could be separately assigned, so the public policy objective set forth by the cou to prevent possible harassment by multiple assignees would not be achieved by the previously filled termi disclaimer. Therefore, terminal disclaimers to patents #5,841,498 and #5,841,499 are still required.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kenneth Parker

Primary Examiner

December 6, 2001

Conferees - TD